

REMARKS

Claims 21-22 have been canceled. No additional amendments or additions have been made to the present claims. Therefore, claims 1, 3-8 and 10-16 are currently pending in the case. Further examination and reconsideration of the presently claimed application are respectfully requested.

Section 103 Rejections

Claims 21-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,373,940 to Shaffer et al (hereinafter referred to as "Shaffer") in view of U.S. Patent No. 6,298,128 to Ramey et al. (hereinafter "Ramey"). Claims 21-22 have been canceled rendering rejection thereto moot.

In addition, claims 1, 3-8, and 10-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer in view of U.S. Patent Application No. 2002/0001301 to Sarkissian (hereinafter referred to as "Sarkissian") and in further view of Ramey. To establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. *In re Bond*, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). None of the cited art teaches or suggests all limitations of the present claims, some distinctive limitations of which are set forth in more detail below.

None of the cited art provides teaching, suggestion or motivation for comparing the category heading of the electronic notification to field headings corresponding to the plurality of directory entries, upon matching an identifier of the electronic notification to an entry identifier associated with the directory entry. Present claim 1 recites in part:

An electronic communications device comprising ... a storage medium comprising program instructions executable by the processor for: receiving an electronic notification of a change to a directory entry stored within the electronic communications device ... automatically updating the directory entry ... wherein the step of automatically updating the directory entry comprises: comparing the identifier of the electronic notification to entry identifiers corresponding to a plurality of directory entries stored within the electronic communications device;

comparing the category heading of the electronic notification to field headings corresponding to the plurality of directory entries, upon matching the identifier of the electronic notification to an entry identifier associated with the directory entry...

The presently claimed case provides a system and method for updating directory entries within an electronic communication device upon receipt of an electronic notification of a change to one or more directory entries. Electronic communication devices may include, but are not limited to telephones, facsimile machines and electronic organizers. The presently claimed system and method allows an existing directory entry (i.e., an entry stored within the directory of the electronic communications device) to be automatically updated upon receipt of an electronic notification of a change to a directory entry and an acceptance command from a user of the device. As recited above, for example, the step of automatically updating the directory entry may include: (i) comparing the identifier of the electronic notification to entry identifiers corresponding to a plurality of directory entries stored within the electronic communications device, and (ii) comparing the category heading of the electronic notification to field headings corresponding to the plurality of directory entries, upon matching the identifier of the electronic notification to an entry identifier associated with the directory entry. (See, e.g., Abstract and present claims).

On page 4 of the Office Action, the Examiner admits that Shaffer and Sarkissian each fail to provide teaching or suggestion for the presently claimed steps of "comparing the identifier of the electronic notification to entry identifiers corresponding to a plurality of directory entries stored within the electronic communications device" and "comparing the category heading of the electronic notification to field headings corresponding to the plurality of directory entries, upon matching the identifier of the electronic notification to an entry identifier associated with the directory entry." As such, the Examiner admits that Shaffer and Sarkissian fail to teach or suggest all limitations of present claim 1.

However, the Examiner suggests that "Ramey teaches comparing the identifier (see figure 2, ID number) of the electronic message to entry identifiers corresponding to a plurality of directory entries stored within the electronic communications device, [and] comparing the category heading (read on caller ID group, E-Mail group) of the electronic message to field headings (read on number filed [sic], name field) corresponding to the plurality of directory entries, upon matching the identifier of the electronic messages to an entry identifier associated with the directory entry." (Office Action, page 4). The Examiner further suggests that it would have been obvious to incorporate the teachings of Ramey into the teachings of Shaffer and

Sarkissian "in order to automatically update the telephone directory and easily reply to an incoming message" (Office Action, page 5). The Applicant respectfully disagrees with the Examiner's assertion that teaching or suggestion for each of the presently claimed steps of comparing can be found within Ramey. Support for the lack of teaching within Ramey is set forth in more detail below.

Ramey discloses a unified directory for caller ID and electronic mail addresses (Ramey, Title). In particular, Ramey provides a communications device and method for making a new entry or updating an existing entry stored within the electronic communications device upon receiving a message in either telephonic or email message format (see, FIGS. 1-3 of Ramey). As shown in FIG. 3, for example, Ramey teaches that when a message is received (step 301), the message address (i.e., the caller ID number for telephone messages, or email address for email messages) is extracted from the message (step 302) and compared to the stored address field for the communications medium of the message (i.e., for telephone messages, the caller ID number is compared to the caller ID number field, and for email messages, the email address is compared to the email address field) for all entries in the database (step 304). (See, column 7, lines 14-23 of Ramey) Therefore, if one were to ignore the fact that the presently claimed "electronic notification" is a "notification of a change to a stored directory entry" (a point which is not taught or suggested by Ramey), Ramey may be interpreted to provide teaching for comparing an identifier (e.g., a caller ID number or email address) of the electronic notification to entry identifiers (e.g., phone number or email address fields) corresponding to a plurality of directory entries stored within the electronic communications device.

However, Ramey provides absolutely no teaching or suggestion for the next step of comparing, which includes "comparing the category heading of the electronic notification to field headings corresponding to the plurality of directory entries, upon matching the identifier of the electronic notification to an entry identifier associated with the directory entry." Instead, Ramey teaches that if an entry matching the identifier is found (step 306), "then the name field for the message communications medium is updated with the message name (i.e., caller ID name for telephone messages, email name for email messages) [and] the database updating is then complete (step 310)." (Ramey, column 7, lines 23-28). In other words, instead of performing another comparison step as presently claimed, Ramey specifically teaches that the name field stored in the directory is updated with the message name from the received message, upon matching the identifier of the electronic notification (i.e., the received telephone or email

address) to an entry identifier associated with the directory entry (i.e., the stored telephone or email address fields). Clearly, one skilled in the art would not consider the updating of name fields, as taught by Ramey, to be equivalent to the presently claimed next step of comparing.

In fact, although Ramey does provide teaching for a next step of comparing (in step 312 of FIG. 3, e.g., Ramey teaches comparing the name field from the received message to the name fields stored within the directory), Ramey specifically teaches that the next step of comparing (i.e., step 312) is only performed if an entry matching the identifier is NOT found (in step 306). See, e.g., Ramey, column 7, lines 29-33. This is altogether different from the presently claimed step of comparing, which compares the category heading of the electronic notification to field headings corresponding to the plurality of directory entries, upon matching the identifier of the electronic notification to an entry identifier associated with the directory entry. As such, Ramey simply fails to provide teaching or suggestion for all limitations of present claim 1.

In addition to explicit or inherent lack of teaching, the cited art cannot be modified to disclose the aforementioned claim limitation, since none of the cited art suggests a desirability for doing so. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination [or modification]. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2143.01. There is simply no motivation within the cited art to modify the teachings of Shaffer, Sarkissian or Ramey to include the aforementioned claim limitation.

Furthermore, since none of the cited art teaches, suggests, or provides motivation for the aforementioned claim limitation, the cited art cannot be combined to do so. As stated above, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed.Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); MPEP 2143.01.

For at least the reasons set forth above, none of the cited art teaches, suggests, or provides motivation for all limitations of independent claim 1. In addition, the cited art cannot be combined or modified to do so. Therefore, independent claim 1 and all claims dependent therefrom, are considered to be patentably distinct over the cited art. Accordingly, removal of this rejection is respectfully requested.

CONCLUSION

This response constitutes a complete response to the issues raised in the Office Action mailed July 1, 2005. In view of the remarks herein traversing the rejections, Applicants assert that pending claims 1, 3-8, and 10-16 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 09-0447.

Respectfully submitted,



Kevin L. Daffer
Reg. No. 34,146
Attorney for Applicants

Daffer McDaniel, LLP
P.O. Box 684908
Austin, TX 78768-4908
Ph: (512) 476-1400
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JMF